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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/785,793      | 02/16/2001  | Bertrand Seraphin    | 70436               | 5538             |

22242 7590 02/18/2004

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EXAMINER

HINES, JANA A

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

1645

DATE MAILED: 02/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/785,793

Applicant(s)

SERAPHIN ET AL.

Examiner

Ja-Na Hines

Art Unit

1645

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 02 October 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: None.

Claim(s) objected to: None.

Claim(s) rejected: 1-11.

Claim(s) withdrawn from consideration: None.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

LYNETTE R. P. SMITH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600

Continuation of 2. NOTE: The amendment will not be entered because it raises new issues that require further consideration and additional search. The newly proposed claims are now attempting change the detectable substances to no longer include proteins, biomolecules complexes, cell components and cell organelles. The amendments is also drawn to increasing the numbers of subunits in the claimed complex which thereby requires further consideration and search.

With respect to applicants' assertion that Darzins et al., does not enable the detection and/or purification of complexes since Darzins et al., is suited for gram-positive bacteria is not persuasive because the claims fail to recite any limitations regarding the methods useable for gram-positive bacteria. The instant claims embrace the Darzin et al., method therefore the rejection is maintained. Moreover, applicants assertion that biological activity is required is not persuasive, since the claims are not limited in such a way. Applicants' arguments do not even point to language in the claim that limits the claims to be commensurate in scope to applicants arguments. Therefore applicants arguments are not persuasive, since the prior art method meets the limitations of the instant claims.

In response to applicant's argument that there is no suggestion to combine the references, the use of alternative and functionally equivalent affinity tags would have been desirable to one of ordinary skill in the art based on the tags ability to be expressed within recombinant fusion proteins; moreover, the tags can be used in affinity chromatography assays and be removed from fusion proteins. One would have a reasonable expectation of success to make a mere alternative or equivalent affinity tag change since Zheng et al, teach their well-known use when only the expected detection and purification results would have been obtained since the prior art clearly teaches the detection and purification of similar and equivalent affinity tags. In response to applicant's arguments against the Zheng e al., reference individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Thus, it would have been prima facie obvious to one having ordinary skill in the art at the time of the invention was made to exchange the affinity tags used the method for detecting and/or purifying substances using multiple affinity tags as taught by Darzins et al., in view of the specific affinity tag of Zheng et al., because Zheng et al., teach that calmodulin binding proteins can be expressed with recombinant fusion proteins, used in affinity chromatography assays and removed from fusion proteins. Therefore the rejection is maintained and applicants' arguments are not found persuasive.